

REMARKS

Claims 44-50, 54, 55, and 58-61 are currently pending in this application. Claims 1-43, 51-53, 56, 57 and 62-74 have been cancelled.

I. CLAIM REJECTIONS UNDER 35 USC § 102(B) TO GOBLE

The Examiner rejected claims 34-43 and 67-70 under 35 U.S.C. §102(b), as being anticipated by Goble et al. (US Patent 6,579,319). This rejection is moot because claims 34-43 and 67-70 are cancelled. Applicant therefore requests that the Examiner withdraw the rejection.

II. CLAIM REJECTIONS UNDER 35 USC § 102(B) UNDER MARTIN (6,132,464) OR FITZ (RE 36,758)

The Examiner also rejected claims 1, 6, 7, 10, 11, 13, and 14 under 35 U.S.C. § 102(b) as being anticipated by either of Martin (6,132,464) or Fitz (RE 36,758). This rejection is also moot because claims 1, 6, 7, 10, 11, 13, and 14 are cancelled. Applicant therefore requests that the Examiner withdraw the rejection.

III. ALLOWABLE CLAIMS

The Examiner has allowed claims 44-50, 54, 55, and 58-66. After entry of the amendment canceling claims, only allowed claims 44-50, 54, 55 and 58-61 remain in this application.

IV. SUGGESTION OF INTERFERENCE UNDER 37 C.F.R. § 41.202 FOR INTERFERENCE WITH PATENT

Pursuant to 37 C.F.R. § 41.202, Applicant hereby requests that an interference be declared between the present application S/N 10/615,727 (the '727 application) and U.S. Patent 6,565,605 (the '605 patent).

The '727 application was filed July 9, 2003, claiming the benefit of priority to non-provisional U.S. Patent Application Serial No. 09/693,272 filed October 20, 2000, now U.S. Patent 6,610,092 (which issued August 26, 2003) and claiming the benefit of priority to provisional U.S. Patent Application 60/160,891 filed October 22, 1999.

The '605 patent issued on May 20, 2003, from patent application S/N 09/736,103 filed December 13, 2000.

A. Identification of Patent For Interference (37 C.F.R. § 41.202(a)(1))

Applicant identifies U.S. Patent No. **6,565,605** to Marlowe E. Goble et al. as the patent with which the Applicant seeks an interference.

B. Presentation of Proposed Counts and Identification of Interfering Claims (37 C.F.R. § 41.202(a)(2))

i. Identify all claims the Applicant believes interfere.

Applicant believes that allowed claims 44-50, 54, 55, and 58-61 inclusive in this '727 application interfere with claims 1-7, 11, 12, 15-18 inclusive of the Goble '605 patent.

Applicant reserves the right to add the previously withdrawn, now cancelled claims, 51-53 and 56-57 also copied from the '605 patent by motion during a subsequently declared interference.

ii. Propose one or more counts.

Applicant proposes 13 counts. The proposed counts correspond to claims 1-7, 11, 12, 15-18 inclusive of the '605 patent. The proposed counts are set forth in **Attachment A**.

iii. Show how the claims correspond to the one or more counts.

Attachment B is a claim chart that provides a side-by-side comparison of Applicant's allowed claims 44-50, 54, 55, and 58-61 of this '727 application, claims 1-7, 11, 12, 15-18 of the '605 patent, and Applicant's proposed counts presented in **Attachment A**.

C. Claims Interfere Within the Meaning of § 41.203(e) (37 C.F.R. § 41.202 (a)(3))

As shown in **Attachment B**, Applicant's claims 44-50, 54, 55, and 58-61 inclusive in the present application anticipate claims 1-7, 11, 12, 15, 16 and 18 of the '605 patent and therefore the claims of the '605 patent interfere with Applicant's claims within the meaning of 37 C.F.R. § 41.203(a) and 35 U.S.C. §102(g).

Claim 17 of the '605 patent recites a spinal implant kit where each of the components are explicitly described in the disclosure of at least Applicant's 60/160,891 priority application (see **Attachment C** for a claim chart that correlates the copied allowed claims of Applicant's '727 application to the written description support in each of the applications that

Applicant claims priority to). Therefore, it would have been obvious in view of a disclosure of a wide assortment of spinal implant components to select some and place them in a kit as is the common and widely accepted practice in the medical and surgical arts.

The disclosure of Applicant's 60/160,891 priority application renders obvious Claim 17 of the '605 patent and therefore the '605 patent interferes with Applicant's claims within the meaning of 37 C.F.R. § 41.203(a) and 35 U.S.C. §102(g).

D. Applicant Will Prevail On Priority (37 C.F.R. § 41.202(a)(4))

Applicant will prevail on priority. The present application enjoys the benefit of priority applications filed October 22, 1999 and October 20, 2000, both of which pre-date the earliest constructive reduction to practice of the '605 patent which issued from U.S. patent application S/N 09/736,103 filed on December 13, 2000. The subject matter corresponding to each of the proposed counts is supported by the present application and Applicant's provisional patent application S/N 60/160,891 filed October 22, 1999, as shown in **Attachment C**.

E. Claim Chart of Applicant's Claims and Specification (37 C.F.R. § 41.202(a)(5))

Applicant appends hereto **Attachment C** which is a chart showing the written description support for each of claims 44-50, 54, 55, and 58-61 inclusive as found in the priority applications of the present application.

F. Constructive Reduction To Practice (37 C.F.R. § 41.202(a)(6))

Applicant further submits that constructive reduction to practice of each claim corresponding to each proposed count occurred upon Applicant's filing of U.S. Provisional Patent Application Serial No. 60/160,891 on October 22, 1999, and/or Applicant's filing of U.S. Non-Provisional Patent Application Serial No. 09/693,272 on October 20, 2000, that claims priority to the U.S. Provisional Patent Application Serial No. 60/160,891 filed October 22, 1999.

CONCLUSION

An early and favorable action declaring an interference between the present application and U.S. Patent 6,565,605 is respectfully requested.

FEE AUTHORIZATION

The Commissioner is authorized to charge any additional fees that may be required, including petition fees and extension of time fees, or credit any overpayment to Deposit Account No. **23-2415** (Attorney Docket No. 29914-701.401).

Respectfully submitted,

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